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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/055,177	01/25/2002	Michel Maillard	1581.0330002	9147
26111	7590	06/24/2005	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX PLLC 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ZAND, KAMBIZ	
		ART UNIT	PAPER NUMBER	
		2132		

DATE MAILED: 06/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/055,177	MAILLARD ET AL.	
	Examiner	Art Unit	
	Kambiz Zand	2132	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 03/29/2005.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-14, 40-43 and 55 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-14, 40-43 and 55 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Kambiz Zand
[Signature]

Attachment(s)

1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____

4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____

5) Notice of Informal Patent Application (PTO-152)

6) Other: _____



DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this section can be found in the prior office action.
2. The prior office actions are incorporated herein by reference. In particular, the observations with respect to claim language, and response to previously presented arguments.
3. Claims 15-39 and 44-54 have been cancelled.
4. Claims 1, 4, 5, 40 and 55 have been amended.
5. Claims 1-14, 40-43 and 55 are pending.

Response to Arguments

6. Applicant's arguments filed 03/29/2005 have been fully considered but they are not persuasive with respect to claims 40-43 and 55.

As per applicant's arguments that Kudelski is silent as to "the receiver/decoder processing memory with a stored ID" page 9, paragraph 4 of Applicant's response, Examiner refers Applicant to the following remarks:

- As previous examiner has stated col.6, lines 21-45 disclose processing memory with a stored id clearly. Col.6, lines 25-28 disclose of memorization of the emissions in the decoder, that is decoder processing memory. The word memorized in line 27 and 28 corresponds to Applicant's storing. Memorized

emissions and its description on lines 28-45 correspond to Applicant's stored id's. therefore Applicant's arguments are not persuasive.

- Examiner further refers applicant's to fig.4 and 8 and associated text with respect to the "the receiver/decoder processing memory with a stored ID". Figure 4 and 8 disclose memory and stored id. However col.6, lines 21-45 by itself address Applicant's arguments clearly. The rejection of claims 40-43 and 55 of the previous examiner has been maintained.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

8. Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, the "adapted to enable or control" phrases makes the claims indefinite and unclear in that neither means/method steps nor interrelationship of means/method steps are set forth in these claims in order to achieve the desired results expressed in the "adapted to enable or control" phrases.

The phrase "adapted to enable or control" creates ambiguity that if such actions are being processed. Examiner suggests the following replacement phrase: "enabling or controlling" in order to avoid confusion. Appropriate corrections are requested.

Double Patenting

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. **Claims 40 and 53** are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 26 of U.S. Patent No. 6,466,671 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because :

Claim(s) 26 of patent # 6,466,671 B1 contain(s) every element of claim(s) 40 and 55 of the instant application and as such anticipate(s) claim(s) 40 and 55 of the instant application.

"A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or **anticipated by**, the earlier claim. *In re Longi*, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); *In re Berg*, 140

F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus). " ELI LILLY AND COMPANY v BARR LABORATORIES, INC., United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

Claim Rejections - 35 USC § 103

11. Claims 40-43 and 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kudelski et al (5,144, 663).

With respect to Claim 40, Kudelski et al meets the limitation of ("a smartcard reader" on column 5, lines 45-48., and the processor coupled to the smartcard reader and arranged to decrypt said signals in dependence upon an output from the smartcard" on Fig. 3., and "memory means containing a stored ID of the receiver/decoder; and means for comparing said stored ID with an ID of a smartcard read by the smartcard reader" on column 6, lines 21-45., and (means for enabling or disabling the decryption of said signals in dependence upon the comparison" on column 6, lines 41-45. It would have been obvious to one of ordinary skill in the art at the time of the invention to have the CPTV card possess dynamically created zones within its memory for storage of decryption data because the card allows for the unscrambling of the emission (video/audio signals) signals.

With respect to Claim 41, Kudelski et al meets the limitation of "wherein said enabling means is arranged to enable or disable said smartcard" on column 5, lines 62-68; and on column 6, lines 1-3.

With respect to Claim 42, Kudelski et al meets the limitation of "wherein said processor is arranged to enable said smartcard in response to a handshake routine between the receiver/decoder and smartcard" on column 6, lines 4-10.

With respect to Claim 43, Kudelski et al meets the limitation of (aid receiver/decoder being arranged to receive and decrypt broadcast video and/or audio signals" on column 5, lines 45-55.

With respect to Claim 55, its limitation is similar to Claim 40 limitation and hence its rejection can be found therein.

Allowable Subject Matter

12. **Claims 1-14** would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kambiz Zand whose telephone number is (571) 272-3811. The examiner can normally reached on Monday-Thursday (8:00-5:00). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on (571) 272-3799. The fax phone numbers for the organization where this application or proceeding is assigned as (703) 872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private

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PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197
(toll-free).



Kambiz Zand

06/22/2005

